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| 09/476,291      | 12/30/1999  | CRAIG S. RANTA       | MICR0230            | 7623             |

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| EXAMINER |
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CHUNG, JASON J

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| ART UNIT | PAPER NUMBER |
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2611

DATE MAILED: 01/26/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/476,291

Applicant(s)

RANTA, CRAIG S.

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/17/03 have been fully considered but they are not persuasive.

The applicant argues on page 10-middle of page 11 that completing a preference profile is not equivalent to selecting coupon categories and Williams (US Patent # 6,075,971) does not disclose selecting coupon categories from a menu of coupon categories. The applicant goes on to argue on page 11, lines 10-24 that the preference profile does not mean the person wants to receive coupons related to that interest and Williams discloses the system attempts to determine what a user likes and sending all the related coupons to a user and the user may only **want** coupons of a specific type. The applicant presents further arguments of the same features on page 11-page 13, line 6. The examiner respectfully disagrees with this assertion. The examiner takes a broader interpretation of the claims. The selection of the coupon categories is done via the completion of the preference profile. Williams discloses client side filtering (column 6, lines 49-56); thus, the user receives coupons that they want when the client filters out the coupons. Furthermore, applying the same logic the applicant has, the user does not necessarily want all the coupons received, rather than most of the coupons that are received.

The applicant argues on page 13, lines 7-25 that Mankovitz (US Patent # 5,523,794) and Williams fails to disclose the mode key and a redeem mode and storage mode. The examiner respectfully disagrees with this assertion. The claim states at least one control key, which means more than one key can be used. Williams meet the limitation on the storing the selected coupon that corresponds to the category in claim 1 rejection. Williams discloses the client system may

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filter out the coupons that satisfy the preference profile (column 6, lines 49-56), which meets the limitation on a storage mode enables the controller to analyze extracted coupon data and saves coupons corresponding to a selected coupon category. Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7), which meets the limitation on the mode key. Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the shift key or predetermined key strokes may be used to redeem the coupons (column 5, lines 41-55). As just disclosed, Mankovitz discloses a mode key that allows the user to save and redeem the coupon. Mankovitz discloses a coupon is displayed to the user (column 5, lines 26-56). Mankovitz discloses the coupons are called to the display when the user is making purchases (column 8, lines 24-40), which meets the limitation on when in redeem mode, displaying a menu of each of the coupons. Regarding a similar argument, the applicant argues on page 14, line 18-page 16, line 19 that the limitation of the storage mode automatically storing coupons and discarding irrelevant coupons are not taught. The examiner respectfully disagrees with this assertion. As previously disclosed, Williams discloses client side filtering the coupons based on the preference profile created by the user, which meets the limitation on the storage mode automatically storing coupons and discarding irrelevant coupons.

The applicant argues on page 13, line 26-page 14, line 12 that the electronic coupon and decoder are integrated. The examiner would like to point out that the applicant's specification states that the coupon and the decoder communicate via a receiver of electronic contacts stated on page 3, lines 9-11. The examiner page also points out that the coupon and the decoder communicate hard wired or wireless and the electronic coupon can be inserted into the decoder

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as stated on page 5, line 9-page 6, line 2 of the applicant's specification. Therefore the newly amended limitation of a common housing encompassing all the components is interpreted by the examiner as the coupon being inserted into the decoder. Mankovitz discloses the controller 12 (decoder) can have a moiety connector 18 and receive a second moiety connector 20 of the coupon (column 3, lines 44-62; figure 1a), which meets the limitation on the decoder, display, the at least one control key, the memory, and the processor being encompassed in a common housing.

The applicant argues on page 15, line 13-page 16, line 12 that Williams nor Mankovitz do not teach the filtering process based on user action. As previously disclosed, Williams discloses the client can filter the transmitted coupon (column 6, lines 49-56); Williams discloses the user sets up the profile (column 5, line 63-column 6, line 48), which meets the limitation on filtering based on user action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-27, 29, 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Patent # 6,075,971) in view of Mankovitz (US Patent # 5,523,794) in view of Small (US Patent # 5,808,689) in further view of Terrill (US Patent # 6,052,755).

Regarding claim 1, Williams discloses the entertainment preferences of network users of a network are observed and recorded by the client for determining a target audience to which coupons are delivered and the users may disclose various preferences as part of registering with the network and the profiles are compiled and generated (column 5, line 63-column 6, line 12). Williams continues by disclosing the preferences that the user sets include sports, activities, television programming, etc. (column 6, lines 13-24), which meets the limitation on at least one control key configured to selectively respond to actuation by a user and the limitation of enabling a user to selectively manipulate the at least one control key to select a setup mode prior to the transmission session and the controller responding to the selection of the setup mode by causing a menu including a plurality of different coupon categories to be presented to the user on the display. The examiner takes the read of the selection of the coupon categories is done via the user creating the preference profile; furthermore, Williams discloses the client side filtering is done based on the preference profile (column 6, lines 49-56).

Williams discloses that the servers provide coupons may broadcast coupons over the network and the coupons are filtered based on preference profiles compiled by the client to be redeemed by the user (column 6, lines 49-56), which meets the limitation on enabling the user to manipulate the control key to select at least one of the different coupon categories and the limitation on automatically analyzing the extracted coupon data produced by the decoder such that only coupons defined by the extracted coupon data that correspond to the at least one of the different coupon categories selected by the user in the setup mode are automatically stored in the non-volatile memory and each coupon defined by the extracted coupon data that does not

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correspond to the at least one of the different coupon categories by the user are automatically discarded. As disclosed, William discloses transmitting a plurality of coupons.

Williams discloses that the coupons may be delivered by the VBI and/or cable broadcast, or by UHF, and/or VHF (column 6, lines 66-67). Williams fails to disclose the decoder and the controller. Mankovitz discloses electronic coupon data is transmitted in the VBI of a television signal (column 5, lines 26-50). Mankovitz discloses encoded data is extracted from the VBI using a VBI decoder (column 2, lines 24-39), which meets the limitation on a decoder configured to receive a video signal during transmission session and to extract coupon data from the video signal producing extracted coupon data.

Mankovitz discloses electronic coupon information is displayed (column 5, lines 46-56), which meets the limitation on a displayed that displays coupons defined by the extracted coupon data.

Mankovitz discloses a microprocessor 35 (controller) (figure 2) that is coupled to RAM (storage) 36 and a liquid crystal display (column 4, lines 13-28), which meets the limitation on a controller being coupled to the storage and a display.

Additionally, Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7). Mankovitz discloses the read key lets the user determine, whether to save the coupon for later redemption (column 5, line 57-column 6, line 5), which meets the limitation on the setup mode. Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the shift key or predetermined keystrokes may be used to redeem the coupons (column 5, lines 41-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams to have a decoder and controller as taught by Mankovitz in order to strip the data from the VBI of the television signal.

As previously disclosed, both Williams and Mankovitz discloses the coupon data is transmitted in the VBI of a television signal. Neither Williams nor Mankovitz discloses the coupon data in the horizontal overscan. Small discloses transmitting data in the horizontal overscan portion of a television signal to avoid interfering with the blanking intervals in order to avoid 60-cycle hum problems (column 3, lines 34-57 and column 5, lines 24-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams in view of Mankovitz to have the data in the horizontal overscan instead of the VBI as taught by Small in order to avoid interfering with the closed captioning signal.

As previously disclosed, Mankovitz discloses the coupons are stored in a RAM (volatile memory) (column 4, lines 12-18 and column 4, lines 35-53). Neither Williams, Mankovitz, nor Small discloses a non volatile memory. Terrill discloses a RAM, ROM, magnetic **and/or** optical media and the like are interchangeable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to have a ROM (non volatile memory) or any other type of memory instead of a RAM as taught by Terrill in order to give more system versatility.

Regarding claim 2, Mankovitz discloses the controller can be connected to the electronic coupon via a hard wire 18, 20 or IR emitter (column 3, lines 44-62 and column 6, lines 53-58). Mankovitz discloses the decoder 50 is part of the controller (column 6, lines 30-39). The examiner would like to point out that the applicant's specification states that the coupon and the

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decoder communicate via a receiver of electronic contacts stated on page 3, lines 9-11. The examiner page also points out that the coupon and the decoder communicate hard wired or wireless and the electronic coupon can be inserted into the decoder as stated on page 5, line 9- page 6, line 2 of the applicant's specification. Therefore the newly amended limitation of a common housing encompassing all the components is interpreted by the examiner as the coupon being inserted into the decoder. Mankovitz discloses the controller 12 (decoder) can have a moiety connector 18 and receive a second moiety connector 20 of the coupon (column 3, lines 44-62; figure 1a), which meets the limitation on the decoder, display, the at least one control key, the memory, and the processor being encompassed in a common housing.

Regarding claim 3, Mankovitz discloses the portable data coupon includes a display (column 3, lines 63-65). Mankovitz discloses the display is a LCD (column 4, lines 18-27).

Regarding claims 4-5, Mankovitz discloses the coupon is displayed as an UPC code (column 8, lines 10-23). Mankovitz discloses the coupon is called up in an UPC code and it is scanned at a cash register (column 8, lines 23-41), which meets the limitation on the UPC being read by a bar code scanner.

Regarding claim 6, as disclosed in claim 1 rejection, Williams, Mankovitz, and Small discloses television broadcast.

Regarding claim 7, Mankovitz discloses the television broadcast comprises commercials (column 5, lines 26-35).

Regarding claim 8, Mankovitz discloses the decoder used in a VCR to perform the functions (column 6, lines 18-28 and column 7, lines 5-12), which meets the limitation on transmission comprises a playback of a video taped program.

Regarding claims 9-10, the claim states at least one control key, which means more than one key can be used. Williams meet the limitation on the storing the selected coupon that corresponds to the category in claim 1 rejection. Williams discloses the user creates a preference profile prior to the transmission of the signal as disclosed in claim 1 rejection, which meets the limitation on a control key comprising a mode key the limitation of further comprising a selecting the setup mode in claim 10 of the application. Williams discloses the client system may filter out the coupons that satisfy the preference profile (column 6, lines 49-56), which meets the limitation on a storage mode enables the controller to analyze extracted coupon data and saves coupons corresponding to a selected coupon category. Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7), which meets the limitation on the mode key. Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the shift key or predetermined key strokes may be used to redeem the coupons (column 5, lines 41-55). As just disclosed, Mankovitz discloses a mode key that allows the user to save and redeem the coupon. Mankovitz discloses a coupon is displayed to the user (column 5, lines 26-56). Mankovitz discloses the coupons are called to the display when the user is making purchases (column 8, lines 24-40), which meets the limitation on when in redeem mode, displaying a menu of each of the coupons.

Regarding claims 11-12, Terrill discloses a RAM, ROM (electrical circuit), magnetic **and/or** optical media and the like are interchangeable.

Regarding claims 13-19 the limitations in claims 13-19 have been met in claims 1, 6, 8-10 rejections.

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Regarding claims 20-21, the limitations in claims 20-21 have been met in claims 4-5 rejections.

Regarding claims 22-23, the limitations in claims 22-23 have been met in claims 11-12 rejections.

Regarding claim 24, 26, 27, 29, 31 the limitations in claims 24, 26, 27, 29, 31 have been met in claims 1, 9 rejections.

Regarding claim 25, the limitations in claim 25 have been met in claim 11 rejection.

3. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Small.

Mankovitz discloses the portable coupon data 10 can join the controller 12 (figure 1) with connectors 18, 20 or with a wireless interface (column 3, lines 44-62). The combination of the portable coupon data 10 and the controller 12 reads on the electronic coupon. Mankovitz discloses coupon data is transmitted in the VBI of a television signal (column 5, lines 26-50). Mankovitz discloses encoded data is extracted from the VBI using a VBI decoder (column 2, lines 24-39), which meets the limitation on providing an electronic coupon including a decoder configured to extract coupon data from the video signal and the limitation on extracting coupon data from the video signal using the decoder in the electronic coupon.

Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7). Mankovitz discloses the read key lets the user determine, whether to save the coupon for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption

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(column 5, line 57-column 6, line 5), which meets the limitation on storing the coupon data extracted by the decoder in the electronic coupon.

As previously disclosed, Mankovitz discloses the coupon data is transmitted in the VBI of a television signal. Mankovitz fails to disclose the coupon data in the horizontal overscan. Small discloses transmitting data in the horizontal overscan portion of a television signal to avoid interfering with the blanking intervals in order to avoid 60-cycle hum (column 3, lines 34-57 and column 5, lines 24-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to have the data in the horizontal overscan instead of the VBI as taught by Small in order to avoid interfering with the closed captioning signal.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

JJC

  
VICTOR R. KOSTAK  
PRIMARY EXAMINER